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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,989	03/26/2004	David Hughes Horne	00179.0002	9603
7590 04/02/2007 K. S. Cornaby Jones Waldo Holbrook & McDonough Suite 1500 170 South Main Street Salt Lake City, UT 84101			EXAMINER ALANKO, ANITA KAREN	
			ART UNIT 1765	PAPER NUMBER
			MAIL DATE 04/02/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/809,989

Applicant(s)

HORNE, DAVID HUGHES

Examiner

Anita K. Alanko

Art Unit

1765

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 14 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

*Anita K. Alanko*  
Anita K Alanko  
Primary Examiner  
Art Unit: 1765

Continuation of 11. does NOT place the application in condition for allowance because:

As to paragraph #1 of the arguments, examiner acknowledges that there is implicit basis for "all" ; this term should merely be added, in the appropriate place, to the specification in order to provide proper antecedent basis for the claim terminology.

As to paragraph #2 of the arguments, examiner acknowledges that there is basis in the specification and provisional application for dipping into the CPC. However, claim 5 is directed to dipping in the etchant, which is not present in the specification. As to the phrase "discrete times", examiner has taken the meaning of "discrete" to mean dipping for several, different distinct times. It appears that applicant interprets it differently as a "prescribed" time - akin to a predetermined (single) period of time. If so, the claim need merely be amended to cite "prescribed time" (which actually is already inherent in the claim since etching occurs for some period of time).

As to paragraph #3, examiner acknowledges that there is implicit basis for "increases the apex radii"; this phrase should merely be added, in the appropriate place, to the specification in order to provide proper antecedent basis for the claim terminology.

As to paragraph #4, "dipping [the etchant] for discrete times" is new matter, as noted above.

As to paragraph #6, claim 4 cites cleaning, not a more limited interpretation argued by the applicant, and therefore the arguments are not commensurate in scope with the claim language. Indeed, applicant also cites to use conventional cleaning processes (page 6 of specification). Examiner is not arguing that the Clerici method is the same as applicant's method, it's only the scope of the claims (which only broadly recite to clean), i.e., the claimed invention, which is the same as Clerici.

As to paragraph #7, examiner notes that none of the claims cite "employing a liquid that penetrates apexes of cracks, expels water and water borne chemicals, prevents water from humidity, splashing or submersion to penetrate to the apexes." Claim 4 cites "can", but this is an optional step, not a required step.

As to paragraph #8, the prior art need not recognize all the advantages of their method. Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics. In re Best, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

In this application, claims 4-5 cite to clean, rinse, dry and etch. Which steps of the prior art are different from applicant's method to provide for a different result?

*3/25/07* *paragraph # 9*  
As to ~~claim~~ 9, Clerici prevents corrosion, which as broadly interpreted is the same as the claimed invention. Perhaps claim 9 could be amended to cite coating with a liquid corrosion preventive compound that has a surface tension lower than 30 dynes/cm, or is imbedded in the cracks of the metal surface, thereby increasing the strength, flexibility and fatigue life...(as in claim 6).